

## REMARKS

Claims 29-51 are pending in this application.

Claims 29, 39 and 48 are independent.

Claims 29, 35, 39, 44 and 48 are amended herein.

Claims 29-30, 33-36, 38-41, 43-45, and 47-50 stand rejected under 35 U.S.C. §102(e) as anticipated by Kitsukawa et al. (U.S. Patent No. 6,282,713). Claims 32, 42, and 51 stand rejected as obvious under 35 U.S.C. §103(a) in view of Kitsukawa. Claims 37 and 46 stand rejected as obvious under 35 U.S.C. §103(a) in view of Kitsukawa and Hendricks et al. (U.S. Patent 5,990,927). To the extent not addressed by the amendments, the rejections are respectfully traversed.

The Examiner relies upon Kitsukawa in rejecting each of the independent claims. Kitsukawa discloses techniques for displaying on-demand product advertising with or without coupons via a broadcast network. For example, in one embodiment without coupons, with general reference to Figure 5 and column 7, line 61, through column 9, line 23, Kitsukawa discloses showing an icon, or other marking, on a television display. This icon, or marking, is associated with an item shown in a television program also being displayed. After a user selects the icon, or other marking, advertising information associated with that item is displayed.

In another embodiment with coupons, with reference to Figures 8 and 9, an icon, or other marking, representing a coupon for an item shown in a television program is displayed along with that program. Upon a viewer's command, a coupon is stored on a removable recording medium such as an IC card, smart card, or optical storage (see, for example, column 11, lines 38-43). In one embodiment, the stored coupon is

redeemed at a retail outlet by the viewer presenting the removable recording medium to the retailer (see, for example, column 11, lines 61-67). In another embodiment, the stored coupon is redeemed by the view via an electronic link with the retailer in which the retailer reads the stored coupon information from the removable recording medium (see, for example, column 12, lines 1-7).

As amended, independent claims 29, 39, and 48 each require, inter alia, that the commerce related information be associated with at least one product available for purchase via the broadcast network. As should be understood from Kitsukawa and the above, Kitsukawa does not teach or suggest a product being available for purchase via the Kitsukawa broadcast network. Rather, a user must either visit a physical retail location, or use an electronic system distinct from Kitsukawa's network, to purchase a product about which information and/or a coupon is displayed through Kitsukawa's network. Kitsukawa did not recognize the advantages of actually being able to purchase a product via the broadcast network, as recognized by the inventors of the present application. Rather, Kitsukawa is merely directed to advertising products. Accordingly, there is no way for the Kitsukawa reference to teach, or even suggest, a product being available for purchase via the broadcast network. Further, and because Kitsukawa did not recognize the advantages of purchase via the broadcast network, there could be no motivation to modify Kitsukawa to achieve the presently claimed invention.

Accordingly, in view of the above, it is respectfully requested that the Examiner reconsider and withdraw the rejection of independent claims 29, 39, and 48, as well as the rejection of the dependencies of independent claims 29, 39, and 48.

The dependent claims of the present application also recite features that are neither taught nor suggested by the applied art. For example, claims 30, 40, and 49 require, inter alia, that the available commerce information be received in response to tuning to a particular channel. The Examiner points to column 2, lines 20-33, column 5, lines 17-30, and column 6, lines 40-55, in rejecting these claims. It is respectfully submitted that all that is disclosed in Kitsukawa is that advertising information may be received simultaneously with broadcast information. The reference does not teach or suggest that the advertising information be received only if tuned to a particular channel. In fact, portions of the Examiner-cited text actually teaches against that recited in the claims. At column 6, lines 42-44, Kitsukawa teaches "advertising information is received along with broadcasts of associated television programs." Thus, advertising information for multiple programs is received at the same time. There is not requirement or teaching in Kitsukawa that the advertising information be received only if a certain channel is tuned. Simply put, the receipt of the advertising information is in no way dependent upon a tuned channel. Accordingly, at least for this reason, it is respectfully requested that the Examiner reconsider and withdraw the rejection of claims 30, 40, and 49.

Claims 32, 42, and 51 require, inter alia, that icon related data and available commerce related information be received via an out-of-band data path. The Examiner acknowledges that such is not taught or suggested by Kitsukawa. The Examiner takes Official Notice that it is "well known and expected in the art to send additional information on an out-of-band path. This allows supplemental information to be sent without using the bandwidth of the broadcasting channels." It is respectfully requested

that, to the extent that the Examiner maintains the rejection of claims 32, 42, and 51, the Examiner make of record and properly apply prior art that teaches that recited in claims 32, 42, and 51.

Claims 35 and 44, as amended, require, inter alia, that the available commerce related information be information regarding purchase of the product. As will be understood from the discussion of the independent claims, above, Kitsukawa neither teaches or suggests purchase-related information, as Kitsukawa merely discloses an advertising technique, not a purchase technique. Accordingly, at least for this reason, it is respectfully requested that the Examiner reconsider and withdraw the rejection of claims 35 and 44.

Claims 37 and 46 require, inter alia, that the commerce related information correspond to a user preference. The Examiner acknowledges that Kitsukawa fails to teach or suggest that commerce related information (Kitsukawa's advertising information) corresponds to a user preference. To cure the deficiency, the Examiner looks to Hendricks. Hendricks discloses airing selected advertising during breaks in a broadcast program that correspond to a user preference. That is, Hendricks teaches replacing regularly scheduled advertising with specialized advertising. Hendricks does not teach suggest the on-demand advertising associated with a program disclosed in Kitsukawa. Further, Hendricks does not teach or suggest the ability to purchase products via a broadcast network, as disclosed and recited in the amended claims of the present application. Neither Kitsukawa nor Hendricks provides any motivation to make the combination put forth by the Examiner. Further, the Examiner has provided

no guidance whatsoever as to how one could possibly make such a combination. The results of such a combination can only be speculated.


Accordingly, at least for these reasons, it is respectfully requested that the Examiner reconsider and withdraw the rejection of claims 37 and 46.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

A handwritten signature in black ink, appearing to read "Sterling W. Chandler", with a long horizontal flourish extending to the right.

Sterling W. Chandler  
Registration No. 51,370

1300 North Seventeenth Street  
Suite 1800  
Arlington, VA 22209  
Tel.: 703-312-6600  
Fax.: 703-312-6666

SWC/